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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,233	02/12/2002	Christian Rappel	112740-312	6748

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

-Office Action Summary	Application No. 09/937,233	Applicant(s) RAPPEL, CHRISTIAN	
	Examiner James S McClellan	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment

1. Applicant's submission of a preliminary amendment (2/12/02) has been entered wherein:

Claims 9-16 are pending

Claims 1-8 were cancelled; and

claims 9-16 were added.

Priority

2. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or

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sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 9-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitations "the telephone network operator" in lines 9-10 and "the telephone network" in line 12. Claim 14 recites the limitation "the telephone data-registering computer" in line 3. Claim 16 recites the limitation "the telephone network operator" in lines 13-14. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,956,391 (Melen et al.) in view of U.S. Patent No. 6,029,150 (Kravitz).

Regarding **claim 9**, Melen et al. discloses a method for electronically processing purchasing and sales transactions using the Internet (11), wherein goods and services may be ordered via at least one personal computer (1) via an access node, and the goods and services are invoiced and paid for electronically (see paragraph bridging columns 3-4), the method comprising the steps of: processing, via the personal computer (1), an order data transfer via a switching office (4, see column 4, lines 28-52); interrupting, at least briefly, access to the Internet (11) starting from the switching office (4) after confirmation of the order; and

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registering, with respect to billing, the order within a respective terminal-related telephone account file via customary processing of the services for use of the telephone network (see column 7, lines 3-8); **[claim 11]** storing the order data and the billing data in a separate memory area of the telephone account file (see column 9, lines 50-67); **[claim 12]** order data and the billing data are stored in coded form (see column 9, lines 50-67); **[claim 14]** establishing a data link to the switching office (see Figure 1) after a menu item has been called and authenticated via the personal computer (1), wherein it is possible to activate the menu even during an on-line state of the personal computer and access the Internet (14); and **[claim 15]** loading the order data onto the terminal via the Internet (11); registering the order data at the service provider (see Figure 3); transmitting the billing data associated with the order, in a separate link, from the terminal memory to the switching office (see Figure 3); registering the billing data at the switching office in a debit file after authenticity checking; and transferring registration of accounts receivable to the service provider with an identifier as a confirmation (see column 8, lines 56-65).

Regarding **claim 16**, Melen et al. disclose An apparatus for electronically processing purchasing and sales transactions using the Internet (14), wherein goods and services are invoiced and paid for electronically, comprising a terminal (1) which is capable of communication and a display (see Figure 1), wherein the apparatus is connected to a switching office (4) via a telephone network ("PSTN", see Figure 1), the switching office (4) setting up access to an Internet access computer via a data line (see Figure 1), the switching office (4) having an internode module for transforming incoming telephone data when data is transferred between the Internet access computer and the apparatus into a format which is suitable for display and storage in the terminal and for transforming data records derived from the Internet

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data transfer into a switching-office format, and wherein the apparatus processes order data transfer via the switching office (4), access to the Internet (14) starting from the switching office (4) being at least briefly interrupted registering, with respect to billing, the order within a respective terminal-related telephone account file via the customary processing of the services for use of the telephone network (see column 7, lines 3-8).

Melen et al. fails to expressly disclose creating a confirmation of the transaction and checking for registered parties with the use of a PIN.

Kravitz teaches creating an order confirmation (see column 24, lines 57-65) and checking for registered parties with the use of a PIN (see column 25, lines 15-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Melen et al. with the express disclose of transaction confirmation and PIN authorization as taught by Kravitz, because PIN's provide better transaction security and confirmations allow both parties to be aware of the final transaction.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Sarkki et al. is cited of interest for disclosing a method for implementing transaction-based billing for telephone services.

Block et al. is cited of interest for disclosing a real-time subscriber billing system and method.

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Nambudiri et al. cited of interest for disclosing a portable electronic terminal and data processing system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

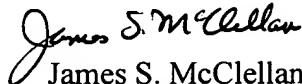
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
November 10, 2003